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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Glick et al.)
Serial No.: 10/051,770)
Filed: January 18, 2002)
For: METHODS AND COMPOSITIONS FOR)
TREATING ADDICTION DISORDERS)

)
Examiner: B. Kwon
Art Unit: 1614

F. TUCK
#8
5/6/03

RESPONSE TO WRITTEN RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the March 25, 2003, written restriction requirement in the above-captioned application, applicants hereby elect, with traverse, the claims of Group I, claims 21-34 and 45-46, drawn to compositions comprising $\alpha_3\beta_4$ nicotinic receptor antagonist(s). Applicants reasons for traversing the written restriction requirement are set forth below.

First, however, by way of clarification, it is applicants understanding that the March 25, 2003, written restriction requirement sets forth a four-way restriction, the four groups being:

- I Claims 21-34 and 45-46;
- II(a) Claims 1-20 and 42-44;
- II(b) Claims 37-41 and 47-50; and
- III Claims 35-36.

With regard to the reasons for concluding that the inventions of Group I and Group II(a) are patentably distinct and with regard to the reasons for concluding that the inventions of Group I and Group II(b) are patentably distinct, which reasons are set forth in the second-to-last paragraph on page 2 of the March 25, 2003, written restriction requirement by referring to the Group II(a) claims and the Group II(b) claims as a single group (i.e., Group II), applicants do not take issue with the written restriction requirement's rationale. However, applicants submit that it is inappropriate to impose a restriction requirement between the Group I claims and the Group II(a) claims, because the invention of Group I and that of Group II(a) are related to one another and would necessarily require common areas of search and consideration (see, MPEP § 808.02). Moreover, applicants submit that it is inappropriate to impose a restriction requirement between the Group I claims and the Group II(b) claims, because the invention of Group I and that of Group II(b) are related to one another and would necessarily require common areas of search and consideration (see, MPEP § 808.02). For at least these reasons, applicants believe that the requirement for restriction between the inventions of Group I and Group II(a) and between the inventions of Group I and Group II(b) is improper and should be reconsidered and withdrawn.

As to restriction between the claims of Group III and the claims of Group I or Group II (i.e., Group I, Group II(a), or Group II(b), the March 25, 2003, written restriction requirement states (at page 2, last paragraph) that these groups are patentably distinct "because the search required in

Group III is not required for Group I or II." While this statement may provide a reason for insisting upon restriction once the related inventions as claimed are shown to be patentably distinct under the criteria of MPEP § 806.05(c)-806.05(i)¹, the March 25, 2003, written restriction requirement provides no acceptable rationale (i.e., under the criteria of MPEP § 806.05(c)-§ 806.05(i)) for concluding that the invention of Group III is patentably distinct from the inventions of Groups I, II(a), or II(b). For at least this reason, applicants believe that the requirement for restriction between the inventions of Group III and Group I, between the inventions of Group III and Group II(a), and between the inventions of Group III and Group II(b) is improper and should be reconsidered and withdrawn.

As to restriction between the claims of Group II(a) and the claims of Group II(b), the March 25, 2003, written restriction requirement provides no rationale for restriction (neither in terms of showing that the inventions of Group II(a) and Group II(b) as claimed are patentably distinct under the criteria of MPEP § 806.05(c)-§ 806.05(i) nor in terms of establishing reasons for insisting upon restriction as discussed in MPEP § 808.02). For at least these reasons, applicants believe that the requirement for restriction between the inventions of Group II(a) and Group II(b) is improper and should be reconsidered and withdrawn.

The March 25, 2003, written restriction requirement also requires that applicants elect a single disclosed species for prosecution on the merits. In response to this species

¹ See, e.g., MPEP § 808.02, second paragraph.

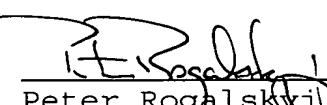
election requirement, applicants hereby elect, without traverse, the species in which the first $\alpha_3\beta_4$ nicotinic receptor antagonist is 18-methoxycoronaridine and in which the second $\alpha_3\beta_4$ nicotinic receptor antagonist is dextromethorphan. Group I claims 21-26, 28, 32-34, and 46 read on this elected species. Each of claims 21-26, 28, 32-34, and 46 is generic to the elected species, and it is applicants' understanding that, if the elected species is found to be patentable, the remaining species encompassed by each elected claim will be examined and, ultimately, the patentability of the generic claims will be determined.

To assist in the examination of the present application, applicants enclose herewith a copy of the International Preliminary Examination Report from counterpart PCT Patent Application No. PCT/US02/02547.

Please note that the correspondence address for the present application has been changed, as indicated in the enclosed Change of Attorney of Agent's Address in Application.

Respectfully submitted,

Dated: April 24, 2003


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date below.

4-24-03
Date

Peter Rogalskyj